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REMARKS

Applicants have carefully reviewed the Office Action dated May 13, 2004. Claims 32-39 are pending in this application. Applicants have amended Claims 32 - 39 to more clearly point out the present inventive concept. Reconsideration and favorable action is respectfully requested.

Claims 32-39 stand rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the Application was filed, had possession of the claimed invention.

The Examiner has objected to the language "an associated printing location." This language indicates that the printer must be disposed in some location and that location is associated with the printer. Applicant believes that this is inherent to any physical device. However, Applicant has amended the language such that it now refers to the location as being the location "of the given engine." Applicant does not believe that this is necessary, but in order to further the prosecution of this case, Applicant has amended this language all the way through the claims to reflect such change.

The Examiner has objected to the use of the term "an accumulator" as not being supported by the Specification. The Applicant has removed this language and has merely referred to the step of accumulating. Applicant believes that this will clarify the claim in light of the Specification.

In subparagraph (d), the Examiner indicated that there was no disclosure as to the step of "decrementing the current toner value in the toner level registered by the accumulated image value for the print engine at the associated printing location and maintaining this value if a comparison of the accumulated image value with the current toner level value if the print engine at the associated printing location indicates that the current toner level minus the accumulated image

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value in the first register is greater than a minimum toner level value associated with the print engine at the associated printer location." Referring to the specification beginning on page 63, paragraph 0145, there is a description set forth wherein the current toner level value in the toner level register is decremented by the accumulated image value for the given print engine at its location. This value is maintained if the toner level value stored in the register prior to this step of decrementing when compared to the accumulated image value indicates that this prior toner level value minus the accumulated image value is greater than a minimum toner level value. This is described beginning at the first line of paragraph 0145 to the 10th line thereof. Applicant believes that the language of the claim has been amended to more clearly clarify that the "current toner level value" was meant to refer to the previous toner value stored in the toner level register prior to the step of decrementing. Applicant believes that the claim as amended is now clear with respect to this subparagraph (d).

With respect to the subparagraph (e) the Examiner has indicated that there was no disclosure in the original Specification wherein the rasterized image is sent "only if the decremented tonal level value associated therewith has been determined to be greater than the minimum toner level." Applicant believes that this is currently supported by the Specification with respect to Figure 33 and the function blocks 790, 792 and 794. It is stated in the Specification, paragraph 145, line 11 that the program will flow to the block 794 and, at that time, the printer will be inhibited from printing that particular job stack. The decremented toner level value is that which is equal to the total toner minus the job toner, set forth in block 784. If it is greater than a minimum value, i.e., it flows along the "N" path from decision block 786, then the job will print. If, however, it is less than the minimum toner level value, then it will flow along a "Y" path from decision block 786 to function block 790. This is clearly described in paragraph 145. As such, Applicant believes that no amendment is required to meet this claim language and, therefor, Applicant believes that there is sufficient disclosure to support the Specification for this language objected to by the Examiner in subparagraph (e).

With respect to the Examiner's rejection in subparagraph (b), the Examiner is specifically

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objecting to the use of the term "substantially" with respect to the number of pixels that are utilized to form the accumulated image value. The claim sets forth, as amended, the step of "accumulating as an accumulated image value toner values . . . of substantially all the pixels in a rasterized image . . ." In the prior response, the Examiner referred to the Specification on page 62, Paragraph 143, Lines 4-6, where it sets forth that the system will "accumulate values of pixels in that page." Further, in Line 7 of Paragraph 143, it is set forth that each pixel will have a value that ranges from 0 to 255 and these are summed up for the entire page. It is not the values that are summed up for each pixel, since there will only be a single value. It is the value of each pixel that is summed up over a page. However, Applicant believes that the Examiner is taking the position that the term "substantially" in and of itself is inherently indefinite.

The Courts have long held that claims that include terms such as "substantial" do not automatically render a claim indefinite, *Exxon Research & Engineering Co. v. United States, 265 F.3d 1371, 1377.* "The degree of precision necessary for adequate claims is a function of the nature of the subject matter." *Miles Labs, Inc. v. Shandon, Inc., 997 F.2d 870, 875 (Fed. Cir. 1993).* A claim limitation is not required to be explicitly excluded in the Specification, as long as one skilled in the art would be able to discern that the claim language reflects the disclosure of the specification. *All Dental Prodx, LLC v. Advantage Dental Prods., 309 F.3d 774, 779 (Fed. Cir. 2002).*

In general, it is only when there is an irreconcilable contradiction within a patent that the claims subject to this contradiction will be rendered indefinite. *See Allen Engineering Corp. v. Bartel Industries, 299 F.3d 1336, 1349 (Fed. Cir. 2002).* In the Specification, although Applicant stated that the summation would have been done for the entire page, Applicant believes that the law sets forth that the term "substantially" as applied to the number of pixels on a page to sum can be interpreted to include most pixels to achieve a desired result. For a given page, there may be seven to ten thousand pixels. If a single pixel were left out, the general result would be same. There is nothing in the Specification to indicate that the lack of a single pixel in the summation operation would change the operation or render the result useless. As such, Applicant believes

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that a fair reading of the Specification would lead to a conclusion that the term "substantially" is not indefinite as the system will work as claimed if a single pixel were left out. Therefore, Applicant believes that the language is not indefinite.

In view of the above, Applicant respectfully requests withdrawal of 35 U.S.C. §112 rejection with respect to Claim 32 - 39.

Claim 32 stands rejected under 35 U.S.C. §103(a) as being unpatentable in view of the combination of *Sakuma* and *Fukui*. This rejection is respectfully traversed with respect to the amended claims.

The Examiner in the response to the arguments indicated that Applicant's priority in this with respect to a notation that the *Sakuma* reference does not "inhibit" transfer of the print job was a distinguishing factor. Applicant noted that what *Sakuma* does is to reduce the ink to the print job and allow the print job to go to that particular printer. Applicant's present invention, as defined by the amended Claims, is set forth wherein the print job is sent to the printer "only if" it is determined that there is sufficient toner to print the job as set forth in the original job description. Further, if insufficient ink is present, then there will be a situation where the printing operation is stopped. However, with *Sakuma*, the image has already been sent to the print engine and there can never be any re-routing of the rasterized image. Although this re-routing is not set forth in the Claim, in order to perform such an operation, it is necessary to determine if there is sufficient toner available prior to sending the job to the printer. Applicant believes that the last paragraph of Claim 32 sets forth this limitation. As such, Applicant believes that the combination of *Sakuma* and *Fukui* does not anticipate or obviate Applicant's present inventive concept, as defined by the amended claims. Therefore, Applicant respectfully requests withdrawal of 35 U.S.C. §103(a) rejection with respect to Claim 32.
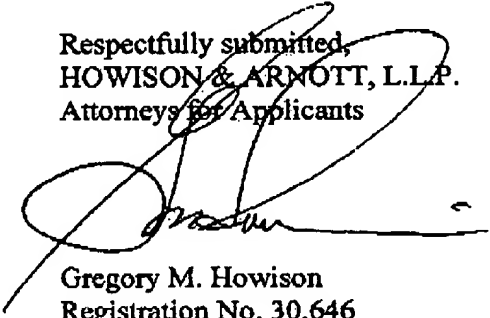
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Applicants have now made an earnest attempt in order to place this case in condition for allowance. For the reasons stated above, Applicants respectfully request full allowance of the claims as amended. Please charge any additional fees or deficiencies in fees or credit any overpayment to Deposit Account No. 20-0780/TRSY-25,474 of HOWISON & ARNOTT, L.L.P.

Respectfully submitted,
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